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August 26, 2008

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Commissioner for Patents  
PO Box 1450  
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10 644 783

*Art Unit 1614*

*Attn: Mail Stop Patent Ext.*

Re: U.S. Utility Patent No. 7,393,872 B2  
Issued: July 1, 2008  
For: **Sodium Channel Blocker Compositions and the Use Thereof**  
Inventor: Nancy C. LAN  
Our Ref: 1483.0370003/JMC/THN

Sir:

Transmitted herewith for appropriate action are the following documents:

1. Credit Card Payment Form (PTO-2038) in the amount of \$200.00 to cover the fee for filing an application for patent term adjustment;
2. Request for Reconsideration of Patent Term Adjustment Under 37 C.F.R. § 1.705; and
3. Return postcard.

It is respectfully requested that the attached postcard be stamped with the date of filing of these documents, and that it be returned to our courier.

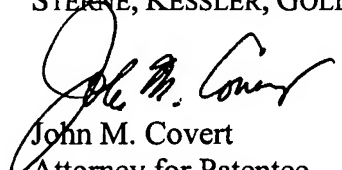
In the event that extensions of time are necessary to prevent abandonment of this patent application, then such extensions of time are hereby petitioned.

Commissioner for Patents  
August 26, 2008  
Page 2

The U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

Respectfully submitted,

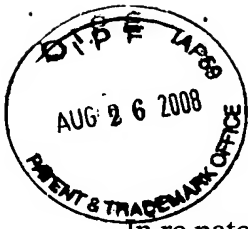
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John M. Covert  
Attorney for Patentee  
Registration No. 38,759

Enclosures

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent of:

Nancy C. LAN

Patent No. 7,393,872 B2

Issued: July 1, 2008

For: **Sodium Channel Blocker  
Compositions and the Use Thereof**

Confirmation No. 6918

Art Unit: 1614

Examiner: KWON, Brian Yong S.

Atty. Docket: 1483.0370003/JMC/THN

**Request for Reconsideration of Patent Term Adjustment  
Under 37 C.F.R. § 1.705**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

*Mail Stop Patent Ext.*

Sir:

Pursuant to 37 C.F.R. § 1.705(b) and 1.705(d), Patentee provides a concise statement of facts involved, as well as payment of fees set forth in 37 C.F.R. § 1.18(e).

***Statement of the Facts:***

Patentee hereby requests that the Patent Term Adjustment for the captioned patent to be corrected to allow an addition of 56 days to the current Patent Term Adjustment of 231 days, the total Patent Term Adjustment being 287 days.

The U.S. Patent and Trademark Office (PTO) mailed a Notice of Allowance and Fee(s) Due on November 8, 2007. This Notice contained a determination of Patent Term Adjustment under 35 U.S.C. § 154(b), which incorrectly indicated that the Patent Term Adjustment (PTA) to the date of the Notice of Allowance and Fee(s) Due was 355 days, *i.e.*, the PTO delay of 418 days (37 C.F.R. § 1.703(a)(1)) reduced by the Applicant delay of 63 days (37 C.F.R. § 1.704(b)).

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On February 8, 2008, Patentee timely submitted the Issue Fee along with a Letter Regarding Patent Term Adjustment Calculations, indicating that the PTA may have been in error in that it may have been longer than appropriate.

On April 3, 2008, the PTO mailed a Letter Regarding Patent Term Adjustment correctly indicating that the revised PTA is 264 days, *i.e.*, the PTO delay of 418 days reduced by the Applicant delay of 154 days (*i.e.*, 63 days + 91 days of the USPTO adjustment). The USPTO adjustment of 91 days for Applicant delay was entered for Applicant taking in excess of three months to respond to the final Office Action mailed January 19, 2007. 37 C.F.R. § 1.704(b).

On July 1, 2008, the PTO issued the above-captioned patent ("the '872 patent") indicating that the term of this patent is extended or adjusted under 35 U.S.C. § 154(b) by 231 days. According to the information currently recorded in the PTO's Patent Application Information Retrieval (PAIR) system, the PTA of 231 days is calculated as follows: the PTO delay of 441 days reduced by the Applicant delay of 210 days (*i.e.*, 119 days + 91 days of the USPTO adjustment).

The information currently recorded in the PAIR system correctly indicates that a delay of 441 days is caused by the PTO. This delay is 23 days longer than that indicated in the Notice of Allowance and Fee(s) Due on November 8, 2007 (*i.e.*, 418 days). This is because the PTO did not issue the above-captioned patent after the payment of Issue Fee on February 8, 2008 until July 1, 2008, four months and 23 days later. 37 C.F.R. § 1.703(a)(6).

The information currently recorded in the PAIR system incorrectly indicates that a delay of 210 days has been caused by Applicant. Patentee agrees that a delay of 154 days has been caused by Applicant as indicated by the PTO on April 3, 2008.

However, Patentee disagrees with the additional delay of 56 days (*i.e.*, 210 days - 154 days) which, according to the PAIR system, was caused by Applicant by submitting an Amendment after Notice of Allowance (Rule 312) on May 7, 2008.

On May 7, 2008, Patentee timely submitted an Amendment and Reply to Office Communication *expressly requested* by the Examiner in a Communication mailed on April 9, 2008. Specifically, the Examiner indicated that the illustrations on page 28 of the specification did not comply with the exceptions of 37 C.F.R. § 1.58(a), and requested that new drawings be submitted, illustrations from the specification be deleted, and text references be amended as necessary.

Patentee respectfully submits that, in the present case, the filing of an amendment after a notice of allowance should not be considered to be a circumstance that constitutes "a failure of an applicant to engage in reasonable efforts to conclude processing or examination of an application" according to 37 C.F.R. § 1.704 (c)(10). To the contrary, Patentee's efforts when judged in view of the recited facts were entirely reasonable and were efforts necessitated by the PTO. As explained above, the Examiner expressly requested the aforesaid Amendment. Patentee timely responded to the Examiner's request by amending the specification and drawings so that the patent application could be published and a patent could issue on time. Any contrary "action or inaction" on part of Patentee would have "prevented or interfered with the Office's ability to process or examine the application", and more importantly, delayed the future issuance of the patent. Therefore, Patentee respectfully submits that the aforesaid Amendment has the practical effects of advancing patent prosecution and cannot reasonably be interpreted as a circumstance of failing to engage in reasonable efforts to conclude processing or examination. To interpret

Patentee's conduct otherwise would directly contradict the scope and intent of enacting 37 C.F.R. § 704(c) and 35 U.S.C. § 154(b)(2)(C)(i). Therefore, the reduction of 56 days from the period of adjustment of patent term is in error.

In view of above, Patentee is entitled to a Patent Term Adjustment of a total of 287 days (*i.e.*, 441 days reduced by 154 days). 37 C.F.R. § 1.703(f).

The above-captioned patent is not subject to a terminal disclaimer. 37 C.F.R. § 1.705(b)(2)(iii).

In addition, there were no circumstances during the prosecution of the application that constitute a failure to engage in reasonable efforts to conclude processing or examination of the application as set forth in 37 C.F.R. § 1.704(c) other than the above mentioned delays of 1) 63 days caused by the failure to respond to the non-final Office Action mailed December 13, 2005 within three months and 2) 91 days caused by failure to respond to the final Office Action mailed January 19, 2007 within three months. 37 C.F.R. § 1.704(b).

It is respectfully submitted that issues raised in this Request could not have been raised in an application for Patent Term Adjustment under 37 C.F.R. § 1.705(b).

In accordance with 37 C.F.R. § 1.705(b)(1), the fee set forth in 37 C.F.R. § 1.18(e) is provided in our accompanying Credit Card Payment Form PTO-2038. It is not believed that additional fees are required beyond those that may otherwise be provided in documents accompanying this paper. However, if additional fees are required, the U.S. Patent and Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to our Deposit Account No. 19-0036.

If it is believed, for any reason, that personal communication will expedite consideration of this Request, please do not hesitate to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Request is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



John M. Covert  
Attorney for Patentee  
Registration No. 38,759

Date: Aug. 26, 2008

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